

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
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In re U.S. Patent Application)

SOPKO et al.)

Application Number: 09/935,843)

Filed: August 24, 2001)

For: METHOD AND SYSTEM FOR PROVIDING
MAINTENANCE SERVICE FOR LONG-TERM
CAPITAL EQUIPMENT OR FIXTURES BY
PROVIDING A WARRANTY)

Attorney Docket No. TREM.0001)

Tech Center 3600

Special Program
Examiner

Randolph A. Reese

Fax (703) 872-9306

Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231**LETTER**

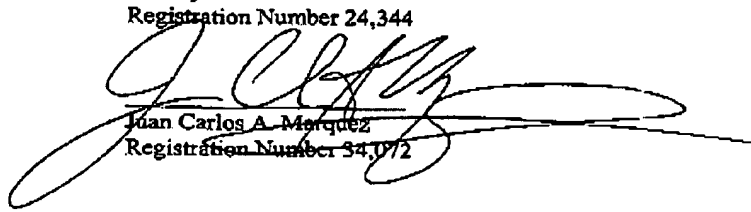
Sir:

The below-identified communications are submitted in the above-captioned application or proceeding:

☒ (x) Renewed Petition☐ () Check for \$0.00

- ☒ [X] The Commissioner is hereby authorized to charge payment of any fees associated with this communication, including fees under 37 C.F.R. § 1.16 and 1.17 or credit any overpayment to Deposit Account Number 08-1480. A duplicate copy of this sheet is attached.

Respectfully submitted,

Stanley P. Fisher
Registration Number 24,344
Juan Carlos A. Marquez
Registration Number 34,072REED SMITH LLP
3110 Fairview Park Drive
Suite 1400
Falls Church, Virginia 22042
(703) 641-4200
December 19, 2003

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RENEWED PETITION

Sir:

This is in response to the Decision on Petition under MPEP 708.02 mailed on December 12, 2003, the period of response to which is set to expire on February 12, 2004. The Petition for accepting the application was denied on the grounds of lacking discussion regarding four listed literature documents. Such discussion is now provided as follows:

The references listed in the webpage of "National Clearinghouse for Educational Facilities: Roof Maintenance and Repair", source(s): NCEF available at http://www.edfacilities.org/rl/roof_maintenance.cfm mainly discuss maximizing the life cycle performance of school roofs via Roof inspection strategies, scheduling, documentation, and repair resources. Only one reference "Covering Your Assets" written by Nicholson, Allen and published by American School and University; v68 n10, p20,22 ; Jun 1996 describes how a roof maintenance program will ensure that schools enjoy optimum protection for occupants and property. That reference discusses how to set up a plan, which includes annual inspections; inventory and documentation, such as recording warranty numbers; and implementing maintenance/repair plans. However, the contemplated warranty is the traditional kind which provided for only limited repairs once a roofing problem (e.g., leakage) is detected and if the problem is included within the

warranty's limited coverage. The warrantor is only responsible for meeting the service requirements as defined by the agreed scope of work. Also, the traditional warranties contain specific provisions that require building owners to properly maintain roof systems during the warranties' terms. A traditional warranty does not replace the need for roof system maintenance or transfer the risk of maintenance to a **maintenance service provider** (defined as "the person, party or entity responsible for the operation of the maintenance service and warranty" page 1, paragraph [1]) to an owner as recited in claim 1 of the present invention ("*warranty, includes transferring from owner to a provider the risk of maintaining performance*").

The reference "Technical Information Center: Literature On Products And Services For Powerplant Design, Operation, And Maintenance" only lists companies providing products and/or services for powerplant design, operation, and maintenance, such as air, in-leak monitor, air-heater cleaning, ball valves, etc. The reference fails to disclose any warranty by a **maintenance service provider** (defined as "the person, party or entity responsible for the operation of the maintenance service and warranty" page 1, paragraph [1]) to an owner as recited in claim 1 of the present invention ("*warranty, includes transferring from owner to a provider the risk of maintaining performance*").

The reference "A Company 100 Years In The Making (Simon Roofing)" published by Indianapolis Business Journal describes the products/services offered by Simon Roofing company. Simon Roofing designs, manufactures, installs and guarantees only its own roofing systems but not systems offered by others. In other words, Simon Roofing's warranty starts from an initial purchase of a new roof rather than "an initial maintenance service" as recited in claim 1. Even if, arguendo, its Renewable Warranty Program were available on or before August 24, 2001, Simon Roofing only allows a two-year warranty for a Simon Roofing system/roof to be renewed for an additional four years for the same Simon Roofing system/roof <http://www.simonroofing.com/Web/witebrite6.htm> After a Simon Roofing specialist performs a two-year roofing inspection, the specialist only makes the necessary one-time maintenance repairs on the Simon Roofing system/roof and applies an additional coat of Wite-Brite™, without "developing a maintenance schedule according to the predetermined start-up standard and any of existing conditions which are beyond the predetermined start-up standard; and maintaining the long-term capital

equipment or fixtures according to the maintenance schedule so as to fulfill the warranty" as recited in claim 1 of the present invention.

The reference "Artful Experts in Mechanical Rejuvenation Tell How and Why They Serve This Critical Niche" published by Printing News was erroneously included in the prior art discussion, since it has nothing to do with roof maintenance.

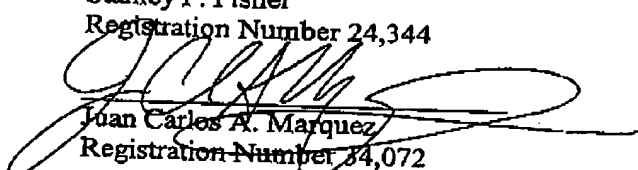
Applicants hereby request reconsideration of the above-referenced petition in view of the above-mentioned supporting information. Specifically, in accordance with the requirements set forth in the Decision on Petition under MPEP 708.02.

In view of the submission of this discussion regarding the four listed literature documents, Applicants respectfully submit that all formal requirements for acceptance of this application for consideration on the merits have been completed. Applicants request that this petition thereby be granted so as to accept this application as complete for consideration on the merits, that an Official Filing Receipt be issued for this application and that the application be forwarded to the appropriate examining group.

The Commissioner is authorized to charge any additional fees necessary or to refund any overpayment to Deposit Account Number 08-1480 for furnishing this Further Supplement to the Petition.

Respectfully submitted,

Stanley P. Fisher
Registration Number 24,344


Juan Carlos A. Marquez
Registration Number 34,072

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FROM: REED SMITH LLP

FAX: 7036414357

TEL: 7036414547

COMMENT:

PAGE 1/7 * RCVD AT 1/23/2004 11:14:58 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:7036414357 * DURATION (mm-ss):02-16

ReedSmith_{LLP}

#7
nzw

TO Special Program Examiner Randolph A. Reese

FROM Juan Carlos A. Marquez

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Date January 23, 2004

Total Number of Pages Including Cover Page 6

Original will follow via: ☐ Regular Mail ☐ Overnight Delivery ☐ Messenger ☐ None

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NOTES: Dear SPE Reese: Per a telephone call to Examiner Thomas Dixon on 1/23/04, we understand that the Renewed Petition to Make Special which we fax-filed on 12/19/03 has not been matched with the file (Serial No. 09/935,843) and therefore the case is not considered an accelerated examination case. Attached please find the renewed petition previously fax-filed together with the USPTO's "Auto-Reply Facsimile Transmission." We would greatly appreciate an expedited decision on this renewed petition. Should you have any question, please contact me. Thank you.

If you do not receive all of the pages, please call at 703.641. .

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